



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

10/04/2004

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,870	03/12/2004	David A. Wright	08411-032002	2238
26191	7590	10/04/2004	EXAMINER	
FISH & RICHARDSON P.C. 3300 DAIN RAUSCHER PLAZA 60 SOUTH SIXTH STREET MINNEAPOLIS, MN 55402				GUZO, DAVID
ART UNIT		PAPER NUMBER		
		1636		

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/799,870	WRIGHT ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	David Guzo	1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 12 March 2004.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 26-41 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 26-41 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>3/12/04</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

**Detailed Action**

**Sequence Listing**

It is noted that the Computer Readable Form (CRF) of the Sequence Listing filed 3/12/04 is correct in listing 190 sequences. However, the Paper Copy of the Sequence Listing only lists 165 sequences. A substitute Paper Copy of the Sequence Listing is required along with a statement that the Paper Copy of the Sequence Listing matches the CRF, an amendment directing entry of the Paper Copy into the specification and a statement that no new matter is being added. Also, sequences are present on pages 63-64, 66, 75, 77 and 79 which are not identified by the appropriate SEQ ID NO identifiers. Any response to this Office Action which does not include complete compliance with the sequence rules will be considered non-responsive.

**Double Patenting**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 26-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5-9, 12-15 of U.S. Patent No. 6,720,479 (hereafter the '479 patent). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are generic to all that is recited in claims 1-3, 5-9 and 12-15 of the '479 patent. That is claims 1-3, 5-9 and 12-15 fall entirely within the scope of claims 26-41 of the instant application or in other words, instant claims 26-41 are anticipated by claims 1-3, 5-9 and 12-15. Specifically, isolated nucleic acids comprising SEQ ID NO:62 (and encoding SEQ ID NO:63) of the '479 patent claims as well as seeds and plants containing said sequences are the same sequences encompassed within the instant claims reading on isolated nucleic acid or amino acid sequences at least 85% or at least 95% identical to SEQ ID NO:62 or 63, respectively.

Claims 26, 29, 30, 33-36 and 38-40 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 and 5 of copending Application No. 10/395,607(hereafter the '607 application). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims represent obvious variants of the claims in the '607 application. The claims in the '607 patent recite isolated nucleic acids comprising a sequence having at least 60% identity to the same SEQ ID NOs (SEQ ID NO:62 and 63) as instantly recited. The difference in the claims is merely that the instant claims recite isolated sequences having at least 85% or 95% identity to SEQ ID

Art Unit: 1636

NO:62 and 63. The subject matter of the instant claims is encompassed within the '607 claims and an examination of the '607 specification indicates that sequences at least 85% or 95% identity to SEQ ID NO:62-63 are recited numerous times (see pages 9, 10, 25, 26, etc.) as embodiments of the invention. The instant sequences must therefore be considered an obvious variation of the claimed invention in the '607 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Closest prior art. The claimed sequence encodes a *Hordeum vulgare* isolate Barley2-19 retrovirus-like element reverse transcriptase. The functional motifs of reverse transcriptases are well known in the art. The closest prior art is exemplified by Laten (U.S.Patent 6,559,359) which discloses various plant retroelements or retrovirus-like sequences. However, the prior art does not disclose or render obvious nucleic acid or polypeptide sequences with the claimed characteristics.

No Claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Guzo, Ph.D., whose telephone number is (571) 272-0767. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Irem Yucel, Ph.D., can be reached on (571) 272-0781. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Guzo  
September 29, 2004

  
DAVID GUZO  
PRIMARY EXAMINER